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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/524,971	03/14/2000	David B Parlour	X-607 US	8836

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EXAMINER

LIPMAN, JACOB

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 10/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/524,971

Applicant(s)

PARLOUR ET AL.

Examiner

Jacob Lipman

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-28 is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 16 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 7-10, 12-15, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 109, 110, and 11, mentioned on page 19 lines 7 and 8. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

3. The disclosure is objected to because of the following informalities:

In the Brief Description of the Drawing, "Figure 4", should read, "Figures 4A and 4B".

Page 13 line 24, 114 should not follow UDI, as the UDI is 116, if 114 is meant to address the query, it should follow the word "queries".

Page 15 line 10 states "condition of authorization code" while Fig 4A, step 204, part 3 states, "condition in the UDI". This contradiction should be corrected.

Page 20 line 15, 119 is not a set of keys, it is the encoder/decoder.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim seems to be incomplete.

***Claim Objections***

6. Claim 17 is objected to because of the following informalities: It does not end with a period. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Probst, US Patent number 5,982,899.

With regard to claim 20, Probst discloses a programmable logic device maintaining, in non-volatile memory, a first key (column 5 lines 40-44). The key is used to decrypt configuration data (column 5 lines 44-45), which is used to configure the device (column 5 lines 58-61).

With regard to claim 21, the identifier number is added to the configuration data (column 5 lines 25-30).

9. Claims 1, 2, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Santon et al., US Patent number 5,058,162.

With regard to claim 1 and 11, Santon discloses a programmable device maintaining a stored private key (column 3 lines 10-13), which is a device identifier (column 2 lines 12-20). The private key is used to decrypt a first encrypted key (column 3 lines 15-18). The first key is then used to decrypt received data files (column 3 lines 18-19). The device is then reconfigured with the data files (column 5 lines 15-22). The definition of configuration, from the Microsoft Computer Dictionary 5<sup>th</sup> edition, is the sum of a system's internal and external components. Thus reconfiguration occurs when software is added.

With regard to claim 2 and 16, Santon discloses the private key is stored in firmware (column 4 lines 17-21).

With regard to claim 3, Santon discloses a first key number (the encrypted first key) that is associated with the encrypted configuration data (It was used to encrypt it), and identifies itself as the key to be used to decrypt the configuration data.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santon.

With regard to claims 4-6, the examiner takes official notice that an EPROM storage element is a form of firmware that is very cost effective if changes are ever required, storing data in non-volatile memory can save processing time in case of power failure, and hardware decryptors work quickly. Santon does not disclose the exact hardware specifications, these are common types of storage and execution devices, and would be obvious to one of ordinary skill in the art to use to gain speed and efficiency.

***Allowable Subject Matter***

12. Claims 7-10, 12-15, 17, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 22-28 are allowed. Jovanovich et al., US Patent number 5,703,950, discloses receiving a device identifier (column 2 lines 29-31), verifying the identified device (column 2 lines 34-36), and using the identifier to encrypt configuration data to be sent to the device identified (column 2 lines 46-55). Jovanovich does not teach the middle step of encrypting a key and the configuration data with that key, and sending them both to the identified device, if it is authorized.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 703-305-0716. The examiner can normally be reached on 7:30 - 5 M-Th, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JL

  
GREGORY MORSE  
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